

Attorney Docket No.: 123260/11886 (21635-0088-01)
Application No.: 10/603,704

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Remarks

This application has been reviewed in light of the Office Action of January 11, 2006. Claims 1-5 and 7-15. Claims 8 and 13-15 are withdrawn from consideration, and claims 1-5, 7, and 9-12 are rejected. In response, the following remarks are submitted. Reconsideration of this application, as amended, is requested.

Restriction

Applicant asks that claims 8 and 13-15 be examined for two reasons.

(1) The refusal to examine claims 8 and 13-15 is incorrect and improper. Species A covered articles that included no recitation that they were previously in service prior to the other steps recited in the claim. Claim 8 and 13-15 are drawn to articles that have no such limitation that they were previously in service prior to the other steps recited in the claims. The limitations referenced in para. 1 of the Office Action refer to limitations subsequent to repair, but do not change the fact that claims 8 and 13-15 contained no such limitation that they were previously in service prior to the other steps recited in the claims, which was the basis of the Restriction Requirement.

(2) In the absence of any arguable basis for rejecting the examined claims, the examined claims should be allowed, and then the species of claims 8 and 13-15 should be examined and allowed.

Action on the Merits

Claim 7 is objected to on the grounds of double patenting, and has been cancelled.

Ground 1. Claims 1 and 3-5

Claims 1 and 3-5 are rejected under 35 USC 102 as anticipated by Hasz U.S. Publication 2002/0189722. Applicant traverses this ground of rejection.

The following principle of law applies to sec. 102 rejections. MPEP 2131 provides: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ... claim. The elements must be arranged as required by the claim..." [citations omitted] This is in accord with the

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decisions of the courts. Anticipation under section 102 requires 'the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim.' Carella v. Starlight Archery, 231 USPQ 644, 646 (Fed. Cir., 1986), quoting Panduit Corporation v. Dennison Manufacturing Corp., 227 USPQ 337, 350 (Fed. Cir., 1985).

Thus, identifying a single element of the claim, which is not disclosed in the reference, is sufficient to overcome a Sec. 102 rejection.

Claim 1 recites in part:

"a turbine vane that, when assembled, is supported on the turbine outer case in a support region whereat a vane-support area of the turbine vane contacts a case-support area of the turbine outer case;"

Hasz does not disclose or illustrate either "a vane-support area of the turbine vane" or "a case-support area of the turbine outer case." Applicant notes that at page 3, second and third paragraphs under heading 5, the Examiner refers to both of reference numbers 14 and 16 of Hasz as the turbine outer case, while referring to both of reference numbers 16 and 12 as the turbine vane. Thus, Applicant is unable to determine what portions of Hasz the Examiner is actually equating with Applicant's claimed invention.

Using the terminology of Hasz, the nozzle 10 illustrated in Hasz is pictured as a free body; nothing is supporting it. No support structure is discussed or pictured in Hasz, and therefore the invention of Hasz does not relate to any such support structure. The nozzle 10 is not supported from either the shroud 14 or the shroud hanger 16. See para. [0010]-[0012] of Hasz and the figure. In the present application, the Examiner is referred to Figures 1-2 to see how vanes 34 are supported from the turbine outer case 22 in the present approach, by a structure that is not discussed or shown in Hasz.

Hasz deals with rubbing between the nozzle 10 and the shroud 14 and/or shroud hanger 16 (see para. [0012] of Hasz), not with the manner in which the nozzle 10 is supported.

In short, Hasz is dealing with a different part of the engine than that recited in present claim 1. It cannot anticipate the recitation of claim 1.

Claim 1 further recites in part:

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"welding a wear-resistant material to a weld area of at least one of the vane-support area and the case-support area".

Because there is no "vane-support area" or "case-support area" disclosed by Hasz, there can be no disclosure of this limitation.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

Ground 2. Claims 1-5 and 7-15

Claims 1-5 and 7-15 are rejected under 35 USC 103 over Applicant's Admitted Prior Art (AAPA) in view of Ingall U.S. Patent 5,360,961 or JP 11-336502. From the explanation of the rejection, Applicant understands that only the Abstract and the drawings, which illustrate the components identified in the Abstract of JP '502, are relied upon, inasmuch as only the Abstract is mentioned and quoted, and no translation of the entire reference is provided. As so understood, Applicant traverses this ground of rejection.

If the rejection seeks to rely on other portions of JP '502, Applicant asks that a full translation of the reference be provided.

The AAPA does not legally qualify as prior art and may not be used in constructing the rejection. MPEP 2129 II provides what may be used as prior art from the Specification:

"Where the specification identifies work done by another as 'prior art,' the subject matter so identified is treated as admitted prior art."

This position is supported in the MPEP by a reference to *In re Nomiya*, "holding applicant's labeling of two figures in the application drawings as 'prior art' to be an admission that what was pictured was prior art relative to applicant's improvement."

The present Specification does not label or otherwise identify anything as "prior art", and specifically does not identify the material in para. [0003]-[0005] as "prior art". Accordingly, under the rules of the MPEP, this material in para. [0003]-[0005] may not be used as admitted prior art for the reasons set forth in MPEP 2129 II, and the AAPA must be withdrawn as a reference to conform to the practice mandated by MPEP 2129 II.

In the present case, the attempted application of the AAPA seeks to use the inventors' own work against them, see the last sentence of para. [0005].

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Ingall discloses improving the wear resistance between two rotating shrouds that may contact each other along their edges by applying a coating to the edges 20 and 22 of the rotating shroud 18 (col. 3, lines 11-21 and Figure 1). JP '502 deals with the same part of the engine as Ingall and deals with the same problem and solution, see Abstract and Figures 1 and 3.

In short, neither Ingall nor JP '502 deals with the subject matter of the present claims, the support of the vane from the outer case.

Claim 1 recites in part:

"a vane-support area of the turbine vane contacts a case-support area of the turbine outer case;"

"welding a wear-resistant material to a weld area of at least one of the vane-support area and the case-support area."

The valid prior art references do not teach these limitations.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

Applicant submits that the application is in condition for allowance, and requests such allowance.

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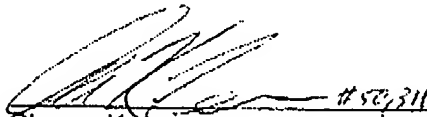
CONCLUSION

For at least the reasons set forth above, Applicant respectfully requests reconsideration of the Application and withdrawal of all outstanding rejections. Applicant respectfully submits that the claims are not anticipated by, nor rendered obvious in view of the cited art, either alone or in combination, and thus, are in condition for allowance. Thus, Applicant requests allowance of all pending claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant's undersigned representative.

This Response has been filed within three (3) months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicant is mistaken in these calculations, the Commissioner is hereby authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

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Respectfully submitted,
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